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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,598	09/27/2001	Gerhard Wennerstrom	1076.40715X00	9391

22907 7590 01/09/2007
BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

EXAMINER

BUI, KIEU OANH T

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/963,598

Applicant(s)

WENNERSTROM ET AL.

Examiner

KIEU-OANH BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,11-21,23-26 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11-21,23-26,28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remark

1. Claims 2, 10, 22, and 27 have been cancelled, and new claims 30-33 have been added. Pending claims for re-examination are claims 1, 3-9, 11-21, 23-26, and 28-33.

Response to Arguments

2. Applicant's arguments filed on 10/30/2006 have been fully considered but they are not persuasive. The amended features and arguments from the attorney are being responded in the following revised office action with further supportive cited paragraphs and explanation/clarification from the examiner as further discussed in details.

Claim Rejections - 35 USC 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

4. Claim 1, 3-9, 11-21, 23-26, and 28-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Abecassis et al. (U.S. Patent No. 6,408,128 B1).

Regarding claim 1, Abecassis discloses a client multimedia apparatus comprising a receiver to receive at approximately the same time primary program data and associated secondary program data from a communication channel, a data storage medium and a data

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processor operable to record the primary program data and the associated secondary program data on the data storage medium as separated files (Fig. 4 for the client multimedia apparatus or multisource multimedia transmitter receiver player, with subscriber at 451, 452, 471 as receiver(s) at the user side, and local storage for recording and storing, and refer to col. 6/lines 13-31 as the multimedia multisource transmitter receiver player including DVD player, TV receiver, DBS receiver, multimedia computing device, a set top box etc.; refer to Fig. 12 and col. 47/line 60 to col. 48/line 8 as resources for variable contents or segments (understood as separate files not a full or complete file) from different storage medium as separate files- further notes in col. 52/lines 29-48); the data processor, subsequent to the storage of the primary data and its associated secondary data being completed, provide a user interface for selection of the program data files and retrieve a secondary program data file selected by a viewer for display (col. 6/lines 31-46 & Fig. 12 and col. 50/lines 1-63 for retrieving, storing, playing and displaying supplemental information as a secondary program data associated with a first primary program data, i.e., col. 4/lines 43-64 for primary or main program data of concerned).

Claim 2 has been cancelled.

As for claim 3, Abecassis further discloses wherein the secondary program data comprises promotional material selected from the group comprising forms: audio, video, pictures, text and graphics (col. 50/lines 36-63).

As for claim 4, Abecassis further discloses wherein the primary program and secondary program data are in the form of MPEG-2 files (col. 8/lines 34-45 as video compression technique is used for MPEG-2 files).

As for claim 5, Abecassis further discloses wherein the secondary program data is of a lower resolution than that of the primary program data (as illustrated in Fig. 17F & 17G, the user/view can designate which one is primary by zooming in the target object or program data, that target becomes primary program data and has higher resolutions than other secondary program data (col. 62/lines 3-17).

As for claim 6, Abecassis teaches this feature for allowing marking of the primary program data for deletion or prolonged keeping upon user input during display of the secondary data (col. 5/lines 40-53 as the supplementary information can be completely substituted the main program data).

As for claim 7, Abecassis further teaches a set top box comprising a multimedia apparatus as cited in claim 1 (col. 6/lines 17-30).

As for claim 8, Abecassis further teaches including a display device for displaying the primary and secondary data received from the storage medium (Fig. 4 with display devices at 451, 452) .

Regarding claims 9, 11-15, and 28-29, these claims are rejected for the reasons given in the scope of claims 1, and 3-8 above, with additional features of computer processing of identifying the copy portions of primary program data that has been earmarked and stored a copy of said earmarked data as an associated secondary program data for subsequently provide a user interface for selection of the stored data files and retrieve a secondary program file accordingly selected by a viewer for display, wherein the primary program data and the secondary program data are stored in separated files (Figs. 9A, 9B, 10 and col. 36/line 13-col. 37/line 55 for multiplay segments and identifying codes and sequences; and refer to Fig. 12 and col. 47/line 60

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to col. 48/line 8 as resources for variable contents or segments (understood as separate files not a full or complete file) from different storage medium as separate files- further notes in col. 52/lines 29-48).

As for claims 16-21, and 23-26, these method claims with same limitations addressed earlier are rejected for the reasons given in the scope of claims 1, and 3-8 above.

As for new claims 31-33, Abecassis further teaches “the secondary programming data provides a trailer for the primary program data” (col. 41/lines 8-22 for trailers as well as linkages to other sources for additional information).

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Krista) Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller, can be reached at (571) 272-7353.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'K. Bui', with a long horizontal line extending to the right.

Kieu-Oanh Bui
Primary Examiner
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KB
Jan.5, 2007